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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/268,080	03/12/1999	PEKKA LONKA	297-008554-U	7914

7590 10/01/2002

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EXAMINER

MAUNG, NAY AUNG

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 10/01/2002

15

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/268,080
Filing Date: March 12, 1999
Appellant(s): LONKA ET AL.

Melvin J. Scolnick
For Appellant

EXAMINER'S ANSWER

MAILED

OCT 01 2002

Technology Center 2600

This is in response to the appeal brief filed 6/25/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that claims 2-5, 13 and 15-19; and 6, 7, and 18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,011,699	Murray et al.	1-2000
6,002,946	Reber et al.	12-1999

Applicant's admitted prior art, Figure 4

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 18, 3-5, 13, 15, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al. (Murray; 6,011,699) in view Reber et al. (Reber; 6,002,946).

Consider claim 18. Murray teaches a telephone comprising (cols. 4 and 5): a first part (fig. 2, item 102), a second part (fig. 2, item 108) attached to the first part movable between a first position and a second position (i.e., open and close position fig. 2, item 211).

In the second part, a keyboard for providing control input information to a radio transceiver (fig. 2, item 214, fig. 7, items 722, 702), an arrangement for attaching battery to the second part parallel to the keyboard (fig. 7, items 722, 706; col. 5, line 45 to col. 6, line 44), and a grip design (fig. 12, item 108) for allowing a user to hold the telephone by the second part (fig. 12).

Murray differ from the present invention in that Murray teaches the transceiver (fig. 7, item 702) is located within the second part of the housing instead of the first part. However, placing the transceiver within the first part or the second part of the housing would have been obvious to one of ordinary skill in the art as a matter of design preference, as evidenced by Reber. Reber teaches a transceiver can be located within a first part or a second part of the telephone housing (col. 7, lines 60-65), given the equivalent in function.

Consider claim 3. Murray further teaches the second part a module (fig. 7, item 718) which having circuit board of the number keyboard; a charging connector to form a connection to an external charging device arranged to charge a battery attached to the second part, and a connector to form an electric connection between the first and the second part (figs. 3 and 7; cols. 4 and 5).

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Consider claim 4. Murray further teaches the connector for forming the electric connection between the first and second part is simultaneously a connector for creating an electric connection between the second part and a battery attached thereto (fig. 3 and 7; cols. 4 and 5).

Consider claim 5. Murray further teaches the module a vibrating alarm device attached to the circuit board of the number keyboard (fig. 7, item 728; col. 6, lines 44-51).

Consider claim 13. Murray further teaches the second part is rotatably movable with respect to the first part in between the first and the second position, for which function the telephone is provided with a hinge in between the first and the second part (fig. 2, item 211).

Consider claim 15. Murray teaches the antenna is a plane antenna located inside the protecting shell within the second part (fig. 7, item 112 and 116). However, the relocating the antenna within first part and the second part is addressed in claim 18 above.

Consider claim 16. Murray further teaches means for receiving an incoming call by adjusting the first part from the first position to the second position (i.e., open position, fig. 2).

Consider claim 17. Murray does not explicitly show the mobile phone is for a digital cellular network. However, the claimed limitation is very well-known in the art and would have been obvious to one of ordinary skill in the art, at the time the invention was made to include digital part such that a user can connect to a digital cellular network in order to have an addition service feature, i.e., a data connection.

Consider claim 19. Murray further teaches the grip by the user is at the area of the lower part of the telephone (depicted in fig. 7, item 108, and a user hand).

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3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable Murray et al. (Murray; 6,011,699) in view Reber et al. (Reber; 6,002,946) as applied to claim 18 above, and further in view of the Applicant's admitted prior art (fig. 4).

Consider claim 2. The combination of Murray and Reber teaches all of the claimed limitations as disclosed in claim 18. In addition, Murray further teaches in the second part a number keyboard (fig. 2, item 214), and the first part having a display (fig. 2, item 204). The combination of Murray and Reber do not explicitly show that the first part having a quick-action keyboard. However, the claimed limitation is very well-known in the art as evidenced by the Applicant's admitted prior art (fig. 4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a quick-action keyboard in order to receive a call by pressing on the quick-action keyboard.

(11) Response to Argument

1. At the outset, the examiner realizes that a typo graphical error incorrectly listed cancelled claim 1 instead of claim 18 in paragraph 2 on page 2 of the previous Office action; therefore, the examiner has changed the rejection set forth in section (10) to accurately reflect the rejection of claim 18 instead of cancelled claim 1.

2. In addition, the examiner agrees with the appellant's argument regarding the applied references to Group II, claims 6, 7, and 18; therefore, the specific rejection of Group II has been withdrawn. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Appellant's arguments with respect to Group I, claims 2, 3-5, 13, and 15-19 have been fully considered but they are not persuasive.

(A) The appellant argued that neither the Murray et al. or Reber et al. references show “an arrangement for attaching battery to the second part parallel to the key board”. The appellant provided a definition of the word “parallel” from the Webster’s Seventh New Collegiate Dictionary, i.e., “parallel” as “extending in the same direction everywhere equidistant and not meeting... everywhere equally distant...” (pages 7-12 of the appellant’s argument).

In response to the argument (A), the examiner respectfully disagrees with the appellant’s argument. First, it is noted that the word “parallel” was first introduced in the appellant’s amendment filed on 3/30/01, paper no. 6. The appellant’s specification does not disclose the definition or the limitation of being “parallel” as: “extending in the same direction everywhere equidistant and not meeting... everywhere equally distant...”. The examiner gave benefit to the limitation of being “parallel” based upon appellant’s figure 6a. Appellant’s figure 6a however does not explicitly show that the battery is parallel to the keyboard, or that if the planes of the battery and the keyboard were extended, that they would not touch each other at some point.

To the extent of appellant’s disclosed “parallel” nature between the battery and keyboard, Marry et al. clearly show a battery and a keyboard which are parallel to each other as depicted in figure 7, i.e., each layer of the telephone lies parallel to the next layer. Furthermore, the examiner would like to draw the appellant’s attention to figure 10, which clearly depicts that the battery, item 706 is parallel to the keyboard, item 720.

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(B) the appellant further argued the Murray et al. patent falls very short of anticipating the appellant's claimed invention. The examiner has cited the Reber et al. patent as a way for making up for this lack of disclosure, and the combination of the references lack of anticipation regarding any specific placing of the parts. The appellant further argued that in the Reber et al. patent there is only general mention that the radio transceiver, processor, speech synthesizer and battery can be placed in whichever part of the telephone, and that the general statement does not anticipate any specific solution nor does it anticipate any specific solution with specific advantages. In addition the appellant argued that the examiner's rejection is completely without legal merit because the prior art reference fails to disclose or suggest a feature specifically claimed by appellant, and that the examiner concludes that what is not disclosed would be "obvious" and that the examiner's combination of the Murray et al. and Reber et al. patent is based upon applicants' own disclosure, i.e., hindsight obtained from appellant's disclosure. The appellant cites a various opinions to bolster this position. (pages 12-18 of the appellant's argument).

In response to the argument (B), the examiner respectfully disagrees with the applicant's argument.

First, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, Murray et al. discloses a flip-style radiotelephone including a bottom housing, a top housing, placing the electronic parts within the housings of the radiotelephone, and the housings are connected by a hinge. In the same field of endeavor, i.e., a flip-style radiotelephone with a top housing and bottom housing which are connected by a hinge, Reber et al. specifically states that the radio transceiver, processor, speech synthesizer and battery may be placed in either part of the flip-style radiotelephone, i.e., leaving up to the designer specific placement based upon engineering decisions.

Motivation to combine Murray et al. and Reber et al. flows from the references themselves, and the motivation to combine is not looking at the appellant's disclosure nor the examiner's assumption. The factual evidence establishing the level of skill of the ordinary artisan is clearly provided by Reber et al. whereby based upon the issues facing a layout designer, placement of a radio transceiver, processor, speech synthesizer and/or battery in the top or bottom part of a flip-style radiotelephone (col. 7, lines 60-65) is a design consideration. The examiner maintain that would have been one of ordinary skill in the art, at the time the invention was made, to have placed the radio transceiver, processor, speech synthesizer and/or battery in the top or bottom part of the flip-style radiotelephone such that the flip-style radiotelephone operates as efficiently and ergonomically as possible.

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(C) The appellant further argued that the prior art of record fails to show as claimed in claims 2, 3-5, 13, and 15-19 based on claim 18 as the reason set forth in the appellant's argument. (pages 18-27 of the appellant's argument)


In response to the argument (C), the examiner clearly addressed the claimed limitations with respect to claim 2, 3-5, 13, and 15-19 in the previously Office action.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


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September 29, 2002

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